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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **MacroLink Inc.**

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Serial No. 74/**536,126**

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**Derrick Michael Reid** for MacroLink Inc.

Peter Cataldo, Trademark Examining Attorney, Law Office 103  
(Michael Szoke, Acting Managing Attorney).

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Before **Cissel**, Hanak and Walters, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 10, 1994, applicant filed an application to  
register the mark shown below



on the Principal Register for "Computer SCSI Bus  
disconnecting electronic circuits," in Class 9. A claim of  
use in interstate commerce since October 15, 1993 was the  
basis for the application.

In addition to noting several other informalities, the Examining Attorney required applicant, under Section 6 of the Act, to disclaim the term "SCSI DISCONNECT" apart from the mark as shown. This requirement was based on his determination that the term is merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Act.

Applicant responded with separate disclaimers of the letters "SCSI" and the word "DISCONNECT," but did not disclaim them together, as a unitary term, as the Examining Attorney had required. Although the Examining Attorney had not objected to the manner in which the goods were identified in the original application, applicant also amended the identification-of-goods clause "to remove ambiguity and more precisely indicate the nature of the goods." Applicant changed the way its product was identified to "Computer SCSI Bus In-Line electronic circuits for electrically isolating SCSI Bus electrical signals." Applicant argued that separate disclaimers are appropriate because the combination of "SCSI" and "DISCONNECT" is not merely descriptive of applicant's product, as specified in the amended identification of the goods.

The Examining Attorney allowed the amendment to the way the goods were set forth, agreeing with applicant that the amendment represents a narrowing of the goods as they were identified in the application as it was originally filed, but he was not persuaded by applicant's argument with

respect to the requirement to disclaim "SCSI DISCONNECT" as a unitary term. The requirement was accordingly made final.

Attached to the final refusal were copies of excerpts from thirty-two stories retrieved from the Nexis database of publications. Some of the excerpts show the term used as a unitary expression in connection with computers. Typical examples include the following: "...performance features like SCSI disconnect and tagged command queues maximize overall data throughput..."; "Version 4.3 brings two major new capabilities to Mac SCSI: asynchronous I/O and SCSI disconnect-reconnect."; "The Fast SCSI-2 card implements the SCSI disconnect/reconnect;" and "In addition, a new SCSI disconnect/reconnect feature permits connection of a host device to a host computer via a SCSI bus with automatic disconnection..." Another article notes that "one particularly valuable feature of the SCSI is its disconnect/reconnect capability."

Applicant responded to the final refusal with additional argument, and attached to its response a copy of part of the SCSI bus specification from the draft American National Standard for the Computer and Business Equipment Manufacturers Association. This specification uses the terms "SCSI bus" and "DISCONNECT," but does not combine the two, e.g., "After the target has received the READ command (and has determined that there will be a delay), it disconnects from the SCSI bus by sending a DISCONNECT message and by going to the BUS FREE phase."

Applicant appealed and filed a brief, but did not request an oral hearing of the appeal. The Examining Attorney also filed a brief, attaching to it copies of excerpts from Microsoft Press Computer Dictionary, Second Edition (1994). The excerpted definitions show that the letters "SCSI" form an acronym for small computer system interface, which is a standard high-speed parallel interface defined by the X3T9.2 committee of the American National Standards Institute. The interface is apparently "used for connecting microcomputers to peripheral devices, such as hard disks and printers, and to other computers and local area networks." The same dictionary defines a "bus" as "a set of hardware lines--wires--used for data transfer among the components of a computer system." <sup>1</sup>

Section 6(a) of the Act permits the Examining Attorney to require an applicant to disclaim an unregistrable component of a mark which is otherwise registrable. Section 2(e)(1) states that a term is unregistrable if it is merely descriptive of the goods on which it is used.

A disclaimer of only the individual component words of a complete descriptive phrase is improper. In re Wanstrath, 7 USPQ2d 1412 (Comm'r Pats 1988); In re Medical Disposables Co., 25 USPQ2d 1801 (TTAB 1992).

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<sup>1</sup>The Board may take judicial notice of these dictionary definitions. See B.V.D. Licensing Corp. v. Body Action Design Inc., 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988).

The issue in this appeal is therefore whether "SCSI DISCONNECT" is merely descriptive of "Computer SCSI Bus In-Line electronic circuits for electrically isolating SCSI electrical signals." Based on the record before us in this case, we hold that it is, and therefore that the unitary term must be disclaimed.

The test for mere descriptiveness is not in dispute. A term is merely descriptive of the goods with which it is used if it immediately and forthwith conveys information about the nature of the goods, their characteristics, features or functions. In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

The Examining Attorney contends that the term in question is merely descriptive of the goods set forth in the application because "SCSI DISCONNECT" describes products which disconnect small computer system interfaces, and that is what applicant's circuits do. He points to the above-referenced definitions as establishing that applicant's goods are used to disconnect SCSI lines or wires, and argues that the articles he made of record with the final refusal demonstrate that the unitary term is recognized in the computer field and that the capacity of an SCSI bus to disconnect is a key feature or characteristic for such goods.

Applicant explains that its in-line bus isolation circuits do not physically disconnect or unplug an SCSI bus

from a system, but rather simply "isolate" the bus electronically, thereby allowing it to be physically disconnected or unplugged by hand without interrupting or otherwise adversely affecting concurrent contemporaneous communications among the SCSI type devices connected to another bus. Applicant argues that its goods do not physically disconnect the SCSI bus, but rather that its bus "isolation" circuits only "enable physical manual disconnection or reconnection without damage or failure on the SCSI bus." (applicant's Jan. 23, 1995 response, p.3).

We agree with the Examining Attorney that in resolving the issue before us, it makes no difference whether the disconnection is physical, in the sense that the bus is manually disconnected, or whether the disconnection is only electrical, in the sense that the bus is electrically "isolated" or taken off the circuit from the rest of the system. As the Examining Attorney points out, the reason he allowed the amendment from "...bus disconnecting electronic circuits" to "...electronic circuits for electrically isolating SCSI bus electrical signals" is because the amended version falls within the broader scope of the original identification, that is, the amended identification "narrows the original to specify electrical disconnection to the exclusion of physical disconnection." (brief, p. 4).

Simply put, "SCSI DISCONNECT" merely describes electronic circuits which are used to disconnect electrically the SCSI bus. That they are left physically

attached does not alter this fact, and does not make the unitary term "SCSI DISCONNECT" any less descriptive of applicant's goods.

Applicant's brief admits as much. At p. 17, applicant concedes, apparently in view of its "duty of good faith candor," that "it may well be asserted that the isolation function of applicant's goods effectively 'disconnects' one bus portion from another by preventing all signals from propagating through the in-line isolation device. The term 'disconnect' is generally defined as 'to sever a connection,' and the isolation function does prevent devices from communicating with each other, and in one sense, severs a connection." A clearer explanation of why "SCSI DISCONNECT" is merely descriptive of these products would be difficult to make.

This descriptive term must be disclaimed apart from the mark as shown. Accordingly, the requirement for a disclaimer of "SCSI DISCONNECT" is affirmed. The refusal to register will be set aside, however, if within thirty days of the mailing date of the ruling, applicant submits the required disclaimer. In that event, the application will be reopened

**Ser No.** 74/536,126

in accordance with Trademark Rule 2.142(g) for the entry of the disclaimer, and then it will be forwarded to publication under Section 12 of the Act.

R. F. Cissel

E. W. Hanak

C. E. Walters  
Administrative Trademark Judges  
Trademark Trial & Appeal Board



**Ser No.** 74/536,126